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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,882	09/15/2006	Siegfried Ansorge	P29677	4700

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EXAMINER	
WANG, SHENGJUN	
ART UNIT	PAPER NUMBER
1627	

NOTIFICATION DATE	DELIVERY MODE
06/03/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/575,882	ANSORGE ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *117-136* is/are pending in the application.

4a) Of the above claim(s) *118,119,123,124,127 and 131-134* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *117,120-122,125,126,128-130,135 and 136* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted February 18, 2010 is acknowledged. The amendments cancel all the prior rejected claims and add new claims 117-136.

The claims have been examined insofar as they read on the examined species presented in the last office action. New claims 118, 119, 123, 124, 127, 131-134 are wherein with drawn from further consideration as drawn non-elected species.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 125, 135 and 136 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 125 recites "stereoisomers" of the compound therein. However, the compound recited in claim 125 has no chiral center and therefore, no stereoisomer. The claim is indefinite as to the "stereoisomers" encompassed thereby. The claim also recites "salt derivatives". The claim and specification provide no clear definition as to the "salt derivatives" recited therein. The claim is indefinite as to the "salt derivatives" encompassed thereby.

Claim Rejections 35 U.S.C. 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 117, 120-122, 128 and 129 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Steffan et al. (WO 02/090534).

6. Steffan et al. teach a method of treating neurological degenerative diseases, such as Alzheimer's disease, comprising administering to the patient a histone deacetylase inhibitor. See, particularly, claim 37. Scriptaid (recited here as A1.009) is disclosed as one of the histone deacetylase inhibitors. See, particularly, pages 25-28. The histone deacetylase inhibitors are formulated with one or more adjuvant and/or pharmaceutical acceptable carrier. See, particularly page 32. As to the recited in the claims. i.e., inhibiting ananyl aminopeptidase, note, the instant claims are directed to affecting a biochemical pathway with an old and well known compounds. The argument that such claims are not directed to the old and well known ultimate utility (treating Alzheimer's disease) for the compounds, e.g., scriptaid, are not probative. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit

distanced by various biochemical intermediates. The ultimate utility for the claimed compounds is old and well known rendering the claimed subject matter anticipated.

Claim Rejections 35 U.S.C. 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 117, 120-122, and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckstein et al. in view of Nakanishi et al. and Emerson et al. (US 5,639,794).

9. Eckstein et al. teaches that hydroxamic acid derivatives Ar-Y-CONHOH, wherein Ar is phenyl substituted with alkyl and/or halogen, and Y is CH2, ArCH, O(CH2)n, SCH2 or NHCH, are systemic fungicides. 2-Methyl-4-chlorophenoxyacetylhydroxamic acid is particularly disclosed. See, particularly, the abstract and table 1 at page 991.

10. Eckstein et al. do not teach expressly the 2-Methyl-4-chlorophenoxy propionohydroxamic acid, nor a composition comprising the hydroxamic acid derivative, a pharmaceutical acceptable carrier and a pharmaceutical acceptable adjuvant.

11. However, Nakanishi et al. teaches that Tween type surfactants are pharmaceutical acceptable adjuvants. See, particularly, page 3258. Emerson et al. teaches that Tween type surfactant is commonly used in agrichemical product, such as antifungal composition, particularly, for those applied to vegetable, fruit, because of little concerns of toxicity. See, particularly, columns 8-10 and the claims.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a hydroxamic acid derivative Ar-Y-CONHOH with Ar as 2-methyl-4-chlorophenyl and Y is O(CH2)2, and a composition comprising the same with water and Tween type surfactant, particularly for applying to fruit or vegetable.

12. A person of ordinary skill in the art would have been motivated to make a hydroxamic acid derivative Ar-Y-CONHOH with Ar as 2-methyl-4-chlorophenyl and Y is O(CH2)2, and a composition comprising the same with water and Tween type surfactant, particularly for applying to fruit or vegetable because such compounds are generally known to be useful as antifungal agents. Further, the compound disclosed by Eckstein et al. that are structural homologs of the instantly claimed compounds, i.e., they differ only by a CH_2 group. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compound because such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. In re Hass, 60 USPQ 544 (CCPA 1944); In re Henze, 85 USPQ 261 (CCPA 1950). The employment of water and Tween type surfactant with the hydroxamic acid derivative for making an antifungal composition would have been obvious because such carrier and adjuvant are taught to be useful as non-toxical carrier particularly for application for eatable plants.

13. Claims 126 is rejected under 35 U.S.C. 103(a) as being obvious over Steffan et al. (WO 02/090534) for reasons set forth above, and in further view of Jackson et al. (WO 01/34594).

14. The teachings of Steffan et al. are discussed above. Steffan et al. do not teach expressly the further incorporation of dipeptidyl peptidase IV inhibitors.

15. However, Jackson et al. teaches that dipeptidyl peptidase IV inhibitors are known to be useful for treatment of central nervous system diseases, particularly, Alzheimer's disease. See, particularly, the abstract, and page 7, lines 1-8.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to further incorporate a dipeptidyl peptidase IV inhibitor in the pharmaceutical composition comprising the compound disclosed by Steffan et al. and to use the same for treating central nervous diseases such as Alzheimer's disease.

A person of ordinary skill in the art would have been motivated to further incorporate a dipeptidyl peptidase IV inhibitor in the pharmaceutical composition comprising the compound disclosed by Steffan et al. and to use the same for treating central nervous diseases such as Alzheimer's disease since it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art. See In re Kerkhoven, 205 USPQ 1069.

Claims 130 is rejected under 35 U.S.C. 103(a) as being obvious over Steffan et al. (WO 02/090534) for reasons set forth above, and in further view of Watkins et al. (WO 02/26696).

Steffan et al. do not teach expressly the treatment of Parkinson's disease.

However, Watkins et al. reveal that histone deacetylase inhibitors are known in the art for treating various neurodegenerative diseases, including Alzheimer's disease and Parkinson' disease. See, particularly, page 111, lines 5-7.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use the method of Steffan et al. for treatment of Parkinson's disease.

A person of ordinary skill in the art would have been motivated to use the method of Steffan et al. for treatment of Parkinson's disease, including any type of Parkinson' disease, as histone deacetylase inhibitors are known to be useful for treating Parkinson's disease.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shengjun Wang/
Primary Examiner, Art Unit 1627